



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,211	09/09/2003	Florian Lang	WWELL73.005AUS	2719
20995	7590	12/12/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			MARTIN, PAUL C	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			1655	

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/658,211	Applicant(s) LANG ET AL.	
	Examiner Paul C. Martin	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/10/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-57 are pending in this application and were examined on their merits.

Election/Restrictions

Applicant's election without traverse of Group I (Claims 1-4) in the reply filed on 11/16/05 is acknowledged. Claims 5-57 are hereby withdrawn from consideration on the merits as being directed toward a non-elected invention. Claims 1-4 were examined on their merits.

Drawings

The drawings are objected to because the photographs in Fig. 3 are not of sufficient clarity so as to ascertain differences between the subjects. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended.

The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures.

Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The use of the trademark Hybond™ has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, part (a), refers to a peptide derived from Serum Glucocorticoid-regulated Kinase 3 (SGK3), however the specification defines the SGK3 derived peptide as "a peptide bearing the enzymatic or catalytic activity of SGK3.." (Page 6, [0022]). From the specification, one skilled in the art would not conclude that the applicants had in their possession at the time of the instant invention, every possible SGK3 derived peptide.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an SGK3 derived peptide bearing the enzymatic or catalytic activity of SGK3, does not reasonably provide enablement for every possible variant of peptide that could be derived from SGK3. The specification does not enable

any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The scope of the claims is not commensurate with the enablement provided by the disclosure with regard to the extremely large number of proteins broadly encompassed by the claims and the claims broadly encompass a significant number of inoperative embodiments.

Since the amino acid sequence of a protein determines its structural and functional properties, predictability of which can be tolerated in a protein's amino acid sequence and still retain similar biological activity requires a (1) knowledge of and guidance with regard to which amino acids in the protein's sequence, if any, are tolerant of modification and which reconserved (i.e., expectantly intolerant to modification), and (2) detailed knowledge of the ways in which the protein's structure relates to its function. However, the problem of predicting protein structure from mere sequence data of a single protein and in turn utilizing predicted structural determination to ascertain functional aspects of the protein and finally what changes can be tolerated with respect thereto is extremely complex and well outside the real routine of experimentation.

One of the main considerations to be made in determining whether undue experimentation is required is the amount of experimentation required. See *In re Wands*, 8 USPQ2d 1400 (CAFC 1988).

Nakai *et al.* (2005) state that, "proteins functions are classified based on function, regardless of whether their sequences or 3D structures are similar or different" (Page 2, 5-12). Therefore, to determine if a derived peptide would have the requisite enzymatic and catalytic activity of SGK3 would require the screening and testing of every possible peptide that could possibly be derived from the SGK3 gene, whether or not sequence homology or 3D structure was conserved or not. This clearly falls into the realm of undue experimentation.

The specification does not support the scope of the claims, which encompass all modifications and fragments because the specification does not disclose the following:

- a) The amino acid sequence for the SGK3;
- b) The general tolerance to modification and extent of such tolerance;
- c) The specific regions of the sequence(s) which are critical for enzymatic and catalytic activity;
- d) What fragments, if any, can be made which retain the biological activity of the intact protein; and
- f) The specification provides insufficient guidance as to which of the essentially infinite possible choices is likely to be successful.

Thus, Applicants have not provided sufficient guidance to enable one of skill in the art to use the claimed SKG3 peptide in a manner reasonably correlated with the scope of the claims, broadly including any number of additions, deletions, or substitutions and fragments of any size.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen *et al.* (WO 00/35946).

Cohen *et al.* teach a method for identifying a compound that modulates the activity of SGK, the method comprising contacting the SGK with a compound under conditions allowing the binding of the compound to the SGK, and determining whether the activity of the SGK is changed in comparison to the activity of the SGK in the absence of the compound. (Page 104, Claim 26).

Art Unit: 1655

Cohen *et al.* teach that the activity of the SGK is the kinase activity. (Page 104, Claim 26, Lines 15-18)

Cohen *et al.* teaches that the compound either inhibits the kinase activity of the SGK (Page 42, Lines 26-29), or that the compound stimulates the kinase activity (Page 43, Lines 10-13)

Cohen *et al.* teaches that the term "SGK", further encompasses a polypeptide termed SGK3 (Page 7, Lines 20-21) and a variant, fragment, fusion or derivative thereof, or a fusion of a said variant or fragment or derivative, wherein the polypeptide is a protein kinase, capable of phosphorylation. (Page 9, Lines 24-29 and Page 10, Lines 1-3)

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole is *prima facie* obvious to one with ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul C. Martin whose telephone number is 571-272-3348. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Martin
Examiner
Art Unit 1655

12/05/05



PATRICIA LEITH
PRIMARY EXAMINER